

Appl. No. 10/688,096
Response Dated December 28, 2005
Reply to Office Action of October 6, 2005

• • R E M A R K S / A R G U M E N T S • •

The Official Action of October 6, 2005 has been thoroughly studied. Accordingly, the following remarks are believed to be sufficient to place the application into condition for allowance.

Claims 1-10 are pending in the application.

Claims 1-3 and 5-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,447,508 to Numano et al. in view of U.S. Patent No. 6,482,195 to Kumasaka.

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Numano et al. in view of Kumasaka and further in view of European Patent Application No. EP 1 243 237 A2 to Mishima et al.

For the reasons set forth below, it is submitted that all of the pending claims are allowable over the prior art of record and therefore, each of the outstanding rejections of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

The Examiner has relied upon Numano et al. as describing:

...a disposable pants-type wearing articles comprising an elastically stretchable chassis (col. 3, lines 11-12), front and rear waist regions, a liquid absorbent panel attached to an inner surface of the outer sheet (Figure 1 and col. 4, lines 20-54). The article comprises a first elastic segment extending in the leg holes 11A-11C, 12A-12C, and a second elastic segment extending in the crotch region (Figure 1).

The Examiner concedes that

Appl. No. 10/688,096
Response Dated December 28, 2005
Reply to Office Action of October 6, 2005

Numano does not disclose the stretch of the elastics and the relationship between the leg-circumferential stretch stress and transverse stretch stress.

Accordingly, the Examiner has relied upon Kumasaka as teaching:

...compression marks might be left on the front thighs if the stretch stress is uniform in all the elastic members and the stretch stress is relatively high. Kumasaka further teaches it is possible to alleviate the problem of compression marks by varying the stretch stress of elastic members in the leg and crotch regions from the elastic placed toward the front and rear panels. Kumasaka teaches varying the stretch stress in the elastic members helps to alleviate the possibility of compression marks and simultaneously provides a fit around the wearer's thighs (col. 1, line 51 through col. 2, line 2, col. 7, line 25 through col. 8, line 9).

In combining the teachings of Numano et al. and Kumasaka the Examiner takes the position that:

One having ordinary skill in the art would have been motivated, based upon the teachings of Kumasaka to vary the stretch stress in the waist region's upper margin to be higher or lower than the leg-circumferential stretch stress to reduce compression marks and discomfort to the wearer.

It is respectfully submitted that the prior art relied upon by the Examiner is not properly combinable and the teachings of the prior art does not suggest the combination that the Examiner purports to be obvious.

First it is noted that Numano et al. and Kumasaka are directed to improving the same type of prior art diapers, in completely different manners to solve different problem.

Numano et al. is directed at improving a diaper (shown in Fig. 2) that has elastic members 51 that extend along the leg-opening cut-outs. Numano et al.'s improvement in to provide elastic

Appl. No. 10/688,096
Response Dated December 28, 2005
Reply to Office Action of October 6, 2005

members 11 and 12 that are configured and aligned to cross one another on longitudinal center areas of the front and rear bodies 5 and 6 as shown in Fig. 1. These continuous elastic members create forces that cause the portions of the front and rear bodies extending from the front and rear waists to the crotch zone to be reliably brought in close contact with the wear's skin when the diaper is wore as discussed at column 2, lines 27-33.

Kumasaka is directed at improving a similar prior art diaper that includes elastic members that extend along the leg-opening cut-outs.

However, Kumasaka's improvement involves the use of overlapping elastic members that remain extending along the leg-opening cut-outs, but which have different stretch stress properties.

It thus becomes clear that the diaper of Numano et al. is structurally different from the diaper of Kumasaka in the manner in which the elastic members extend.

Moreover, it is also clear that the diaper of Numano et al. is functionally different from the diaper of Kumasaka.

There are numerous prior art diapers that include continuous elastic members that extend between the front and rear waist regions and cross one another in various manners/patterns. See for example U.S. Patent No. 6,179,820 to Fernfors (of record).

In such diapers the elastic members are required to be continuous in order to provide the desired elastic forces for which the elastic members are patterned and aligned.

Appl. No. 10/688,096
Response Dated December 28, 2005
Reply to Office Action of October 6, 2005

As those skilled in the art would realize the elastic members 11 and 12 of Numano et al. are required to be continuous in order to exert the necessary forces across the front and rear waist portions.

Accordingly, it is submitted that if the discrete, overlapping elastic members of Kumasaka were used in Numano et al. as the Examiner suggests, the result would adversely affect the continuity of the force created by the elastic members, and thus adversely affect the diaper of Numano et al.

As such, the proposed modification/combination is improper under the standard of obviousness as set forth in 35 U.S.C. §103, noting the holding by the Board of Appeals in *Ex parte Hartmann*:

References cannot properly be combined if effect would destroy invention on which one of reference patents is based. *Ex parte Hartmann*, 186 USPQ 366 (PTO Bd App 1974)

Moreover, it is pointed out that the elastic members in Numano et al. do not extend along the leg-opening cut-outs in a curved manner, but only extent parallel to the central linear portion of the leg-opening cut-outs. (See Fig. 1).

Thus, the teachings of Kumasaka are not even applicable to Numano et al.

There are no areas in Numano et al. that correspond to the areas where Kumasaka provide for elastic members 5c and 5b which have stretch stresses smaller than 5a and with the stretch stress of 5c > the stretch stress of 5b.

Thus it can be concluded that Numano et al. does not create compression marks in these areas (certainly not absent adjacent elastic members).

Appl. No. 10/688,096
Response Dated December 28, 2005
Reply to Office Action of October 6, 2005

Therefore the teachings and solution of Kumasaka are not at all applicable to Numano et al.

In combining the teachings of prior art references the Examiner cannot merely identify isolated teachings and propose their combination absent some teaching or suggestion in the references to support their use in the particular claimed combination. (See *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, USPQ 2d 1468, 1475 (Fed. Cir. 1988))

Moreover the Examiner cannot focus on the isolated teachings of a reference and ignore the other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (See *In re Wesslau*, 147 USPQ 391 (CCPA 1965))

Kumasaka might teach the use of discrete overlapping elastic members that have different stretch stress values. However, a careful reading and understanding of Kumasaka shows that these teachings are not at all applicable to Numano et al.

The Examiner has relied upon Mishima as teaching a protrusion in an absorbent article. This reliance upon Mishima does not address or overcome the Examiner's reliance upon Numano et al. and Kumasaka discussed above.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

Appl. No. 10/688,096
Response Dated December 28, 2005
Reply to Office Action of October 6, 2005

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

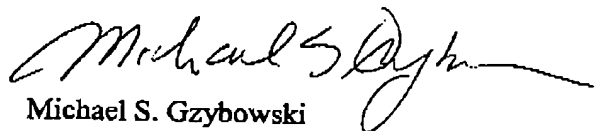
Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remains outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



Michael S. Gzybowski
Reg. No. 32,816

BUTZEL LONG
350 South Main Street
Suite 300
Ann Arbor, Michigan 48104
(734) 995-3110

141311.1